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11-12-03

IN THE UNITED STATES

PATENT AND TRADEMARK OFFICE

APPLICANTS: Tom Van Horn, Richard V. Halbert, and Dale A. Woodford
APPLICATION NO.: 09/686,778
FILING DATE: October 11, 2000
TITLE: SYSTEM AND METHOD FOR EXTENSION OF GROUP BUYING THROUGHOUT
THE INTERNET
EXAMINER: Jeffrey A. Smith
GROUP ART UNIT: 3625
ATTY. DKT. NO.: 22930-06085

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GROUP 3600

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Dated: October 28, 2003

By:

Robert A. Hulse
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RESPONSE TO RESTRICTION REQUIREMENT

Sir:

This is made in response to the Office Action mailed September 30, 2003. In that Office Action, the examiner imposed a restriction requirement and classified each of the pending claims in the following two groups:

Group I: Claims 1-10, 15-27, and 32-38

Group II: Claims 11-14 and 28-31

The basis for this restriction requirement was that the claims in the two groups are related as subcombinations disclosed as usable together in a single combination. Applicants provisionally elect to prosecute the subject matter of claims 1-10, 15-27, and 32-38 of Group I in this application. However, Applicants respectfully disagree with and traverse the requirement to elect between the two groups.

MPEP § 803 recognizes two separate requirements that an examiner must show to make a proper restriction requirement:

1. The inventions must be independent or distinct as claimed; and
2. There would be a serious burden to examiner the application unless restriction is imposed.

Where subcombinations are restricted, the distinctness requirement is governed by MPEP § 806.05(d) and the burden requirement by MPEP § 808.02. Although the Office Action addresses the first requirement that the groups be distinct as claimed, it completely ignores the second requirement of showing a burden on the examiner. In fact, there would be no such burden for examining all claims together in a single application.

As the MPEP explains, it is not sufficient for an examiner merely to establish distinctiveness between two groups related as subcombinations disclosed as usable together in a single combination. To restrict the groups, the examiner must also identify reasons for insisting on restriction, such as (A) separate classification, (B) separate status in the art, or (C) a different field of search.¹ As a corollary to this requirement, "[i]f the search and examination of an entire

¹ MPEP § 808.02 explains that an examiner must and how an examiner can show these reasons:

Where the related inventions as claimed are shown to be distinct under the criteria of MPEP § 806.05(c) - § 806.05(i), the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following:

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application can be made without serious burden, the examiner must examine it on the merits,
even though it includes claims to independent or distinct inventions." MPEP § 803. Not only
does the Office Action fail to show a burden under any of these three criteria, it actually
establishes that no burden exists.

Both groups involve aggregating demand in group-buying sales conducted across an
electronic network. The only identified difference between the groups is that the claims of
Group I, unlike those of Group II, "are not directed to the respective sale of multiple featured
items." But the claims of Group I are directed to the respective sale of at least one featured item.
As asserted in the Office Action, therefore, the only difference between the groups is that Group
II involves sales scheduling for multiple featured items, whereas Group I requires only a single
featured item. In essence, Group I is an instance of Group II – a single transaction compared to
multiple transactions. This distinction does not create a serious burden on the examiner that
justifies a restriction requirement.

Regarding the first reason that can justify insisting on restriction, the examiner has
admitted that Groups I and II have the same art classification. By classifying both groups in

(A) **Separate classification thereof:** This shows that each distinct subject has attained recognition
in the art as a separate subject for inventive effort, and also a separate field of search. Patents need
not be cited to show separate classification.

(B) **A separate status in the art when they are classifiable together:** Even though they are
classified together, each subject can be shown to have formed a separate subject for inventive effort
when an explanation indicates a recognition of separate inventive effort by inventors. Separate status
in the art may be shown by citing patents which are evidence of such separate status, and also of a
separate field of search.

(C) **A different field of search:** Where it is necessary to search for one of the distinct subjects in
places where no pertinent art to the other subject exists, a different field of search is shown, even
though the two are classified together. The indicated different field of search must in fact be pertinent
to the type of subject matter covered by the claims. Patents need not be cited to show different fields
of search.

**Where, however, the classification is the same and the field of search is the same and
there is no clear indication of separate future classification and field of search, no reasons
exist for dividing among related inventions.**

class 705, subclass 26, the examiner has acknowledged that the groups are not drawn to different subject matter that would require a search in a multiplicity of classes. Of course, under MPEP § 808.02, this identical classification only shows that the first reason does not apply here, but it will also be apparent that the other two reasons do not apply. Groups I and II do not have a separate status in the art, nor do they involve a different field of search.

To show that two groups have a separate status in the art, the examiner must provide "an explanation [that] indicates a recognition of separate inventive effort by inventors." MPEP § 808.02. The Office Action fails to explain how Groups I and II involve such a separate inventive effort by the inventors. The identified difference between the groups, as explained above, is merely that they involve different quantities of featured items. However, this is hardly a recognition of a separate inventive effort by the inventors between the groups. Instead, it merely reflects that one group of claims describes the invention in terms of a single transaction while the other group describes the invention in terms of multiple transactions. But merely repeating a transaction or process does not typically cause the transaction or process to attain a separate status in the art within the meaning of MPEP § 808.02.

The third reason that can justify restriction – that the groups involve a different field of search – is similarly absent from the Office Action. A different field of search is shown "where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists." MPEP § 808.02. As explained above, the only distinct subject identified in the Office Action is that Group I does not involve multiple featured items. But nowhere does the Office Action explain how this distinction forces the examiner to search where no pertinent art to the other subject exists. As with the second reason, the identified difference between the two groups is not a justification under this third criterion.

Set-up module required to manage multiple items. Divergent subj.

not the case

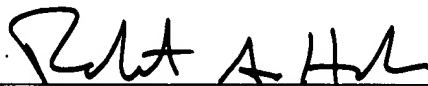
Accordingly, there has been no showing of burden based on any of the three possible reasons outlined by MPEP § 808.02. Moreover, the identical classification of the groups and the only difference between them indicate that there would be no burden on the Office to examine all of the claims in a single application. The justification of burden completely absent, the Office Action has failed to establish a prima facie case for the restriction requirement. Where "the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search," the MPEP explains, "no reasons exist for dividing among related inventions." MPEP § 808.02. In such a case, as here, the examiner cannot require restriction – even between groups of claims that are truly distinct.

Based on the foregoing, Applicants respectfully request that the restriction requirement be withdrawn. If the examiner maintains this restriction requirement based on new reasons, the examiner is requested to issue a non-final restriction requirement so Applicants may have an opportunity to address the newly provided reasons. If the examiner believes that direct contact would help resolve this issue, the examiner is encouraged to telephone the undersigned at the number given below.

Respectfully submitted,

TOM VAN HORN, RICHARD V. HALBERT,
AND DALE A. WOODFORD

Dated: Oct. 28, 2003

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PTO/SB/21 (modified)
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TRANSMITTAL FORM <i>(to be used for all correspondence during pendency of filed application)</i>	0001/PTO REV 10/95	U.S. Department of Commerce Patent and Trademark Office	Application Number	09/686,778
			Filing Date	October 11, 2000
			First Named Inventor	Tom Van Horn, et al.
			Group Art Unit Number	3625
			Examiner Name	Jeffrey A. Smith
Total Number of Pages in This Submission		7	Attorney Docket Number	22930-06085

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